

REMARKS

Claims 1-22 are pending in the present Application, with claims 20-22 withdrawn from consideration. No claims have been amended or canceled, leaving Claims 1-19 for consideration upon entry of the present Response. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Double Patenting

Claims 1-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/797975. Applicants respectfully request that the examiner withdraw the “provisional” obviousness-type double patenting rejection until the claims are in final form and condition for allowance; until such time, there is no double patenting and no way to determine double patenting. MPEP § 804.01.I(B)(1).

Claim Rejections Under 35 U.S.C. § 102(b) and Under 35 U.S.C. § 103(a)

Claims 1 – 19 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by U.S. Patent No. 6,365,066 to Podszun, et al., or as allegedly obvious under 35 U.S.C. § 103(a) over Podszun et al. Applicants respectfully traverse this rejection.

The present claims are directed to an article that effectively releases biocidal metals from the exterior surface of the article. Claims 1-5 of the present application are directed to an article comprising an inorganic biocidal agent wherein the article has a biocidal metal release factor greater than 2.5. The biocidal coating of the present claims can therefore advantageously reduce the growth of pathogenic organisms due to the effective release of biocidal metals. Further, claims 6-19 are directed to an article having a textured exterior surface. As disclosed in the Examples, the textured exterior surface improves the biocidal metal release properties of the article.

Podszun et al., in contrast, is directed to antifouling coatings that are applied to articles in contact with sea water to prevent infestation (i.e., attachment and growth) of algae and other marine organisms. (Abstract, Col. 1, ll. 57-59) Despite stating that the disclosed coatings should be heavy-metal free (Col. 1, ll. 44-45), Podszun et al. does teach that the coatings may contain a

heavy-metal containing biocide such as a zeolite. (Col. 8, ll. 14-27) Podszun et al. fail to teach or suggest an article having the specific biocidal metal release properties, killing of E. coli or Staphylococcus aureus, or a textured exterior surface as required by the present claims.

In making the rejection the Examiner states that Podszun et al discloses “the less preferable embodiment, such as the composition comprising heavy metal containing biocides”. (Paper 120805, Page 4)

To anticipate a claim, a reference must disclose each and every element of the claim. *Lewmar Marine v. Variant Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Further, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Applicants submit that the Examiner has not met the burden of showing that all elements of the invention are disclosed in the prior art.

Applicants concede that Podszun teaches that the coating may comprise a heavy-metal containing biocide such as a zeolite. However, Podszun et al. does not disclose the amount of zeolite to be employed and certainly does not disclose an article “wherein the article has a biocidal metal release factor of greater than 2.5 from an exterior surface”. In addition, Podszun et al. includes no examples of compositions comprising biocidal metals and thus discloses no composition that could inherently anticipate a composition of the Applicants’ claims. The biocidal metal release claimed in the present application is nowhere taught in Podszun et al., thus Podszun et al. is missing a key element of the present claims and cannot anticipate or render obvious the present claims. The mere suggestion of the presence of a biocidal metal is not sufficient to anticipate or render obvious the present claims which require very specific metal release properties that give the articles their biocidal properties.

In addition, Podszun et al. also fail to disclose an article comprising a textured exterior surface as required by present Claims 6-19. There is no teaching or suggestion in Podszun et al. that texturing the surface of an article can lead to improved biocidal activity. A smooth surface would correspond to the Examples of the present Application which are labeled “As such.” As shown in Tables 6 and 7 of the Application, the smooth surfaces of non-textured films exhibit less effective biocidal metal release properties. Thus, a textured article is also not taught by

Podszun et al. Further, Claim 9 requires that the texturing is effective to “to kill at least 50% of a pathogenic organism in contact with the exterior surface over a period of 24 hours at 25°C”.

Podszun et al. does not address the killing of pathogenic organisms and thus does not anticipate this claim limitation.

Further, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

The present application claims an article having specific biocidal metal release properties. Claims 3 and 6-19 of the present application further require that the article comprise a textured surface. As described above, Podszun et al. fails to teach or suggest an article that has the claimed metal release properties. The goal of the Podszun et al. coatings is to prevent infestation of articles, such as boat hulls, by killing marine organisms that attempt to directly attach to the treated hull without harming other organisms that are present in the harbor. Podszun et al. achieve this goal by, *inter alia*, eliminating or reducing the release of biocidal agents into the seawater. When reading Podszun et al. as a whole, one of ordinary skill in the art would not be motivated to modify the composition of Podszun et al., which limits the release of metals when contacted with a solution (e.g., sea water), to provide an article that provides the level of release of biocidal metal that is presently claimed.

Further, as described above Claims 6-19 are directed to a textured article. There is no disclosure of textured articles in Podszun et al., thus this reference does not provide the motivation to texture an article as claimed in the present application.

For at least the foregoing reasons, reconsideration and withdrawal of the foregoing rejections are respectfully requested.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and withdrawal of the rejections and allowance of the case are respectfully requested.

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If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 50-3621.

Respectfully submitted,

CANTOR COLBURN LLP

By Karen A. LeCuyer
Karen A. LeCuyer, Ph.D.
Registration No. 51,928

Date: January 12, 2006
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No.: 23413